

REMARKS

The following remarks are responsive to the Office Action mailed March 9, 2004 (Paper No. 20). Claims 35, 39, and 43 have been amended. The claims presently examined include claims 34-45. Applicants respectfully request allowance of those examined claims.

Rejection Under 35 U.S.C. § 112, ¶ 1

The Examiner rejected claims 3, 6, 14, 15, 25, and 28 under 35 U.S.C. § 112, ¶ 1, for allegedly lacking enablement. (Paper No. 20 at page 3). Applicants respectfully traverse the rejection. To maintain an enablement rejection, the Examiner bears the burden of establishing that one skilled in the art would require undue experimentation to practice the claimed invention. The Examiner lists eight factors from *In re Wands*, 8 U.S.P.Q. 2d 1400 (Fed. Cir. 1988), that may be considered for an undue experimentation analysis. (Paper No. 20 at page 3) The Examiner then proceeds to discuss only the breadth of the claims and the guidance in the specification concerning the Envelope Caller example (Paper No. 20 at pages 3-5). The Examiner, however, failed to explain how those factors establish that one skilled in the art would require undue experimentation to practice the claimed invention. In fact, the Examiner fails to present any assertions about the level of experimentation that he considers necessary. Accordingly, the Examiner failed to establish a *prima facie* case of non-enablement. Until the Examiner establishes such a case, the claims are presumed to be enabled by the specification. Therefore, Applicants request the Examiner to withdraw this rejection.

Rejection Under 35 U.S.C. § 112, ¶ 2

The Examiner rejected claims 35-37, 39-41, and 43-45 under 35 U.S.C. § 112, ¶ 2, for allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (Paper No. 20 at page 5). Specifically, the Examiner questions whether

the determined nucleic acid length, panel determination, and energy computation information of the claims was intended to be information for analyzing the signal. (*Id.*). Claims 35, 39, and 43 have been amended to further clarify that the nucleic acid length, panel determination, and energy computation information are used for analyzing the signal. Therefore, Applicants request the Examiner to withdraw this rejection.

Rejection Under 35 U.S.C. § 102(b)

The Examiner rejected claims 34, 38, and 42 as allegedly being anticipated by Palsson et al., *Using Quality Measure to Facilitate Allele Calling in High-Throughput Genotyping*, Genome Research, Vol. 9, pp. 1002-12 (“Palsson”). (Paper No. 20 at page 6).

Applicants respectfully submit that claims 34, 38, and 42 are not anticipated by Palsson. Independent claims 34, 38, and 42 recite, *inter alia*, “analyzing the signal to determine if the signal meets a threshold test of an allele caller making a correct call” or “analyze the signal to determine if the signal meets a threshold test of an allele caller making a correct call.” These claims further recite, *inter alia*, “making an allele call for the signal if the threshold test is met” and “make an allele call for the signal if the threshold test is met.”

Palsson fails to perform any threshold test when making an allele call. Instead, Palsson discusses taking already-made allele calls of an caller program (Decode-GT) and filters them according to heuristic criteria to classify them as good, bad, or ambiguous calls (Palsson, at 1003-1005). Thus, Palsson discusses processing allele calls as opposed to using a threshold test to analyze data and determine if an allele call should be made. Accordingly, Palsson fails to disclose at least the above elements of claims 34, 38, and 42.

CONCLUSION

Applicants request the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

If the Examiner does not agree that the application is in condition for allowance, Applicants request the Examiner to call the undersigned at 650-849-6680 to schedule an interview.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: September 9, 2004

By: _____

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Date: September 9, 2004

Signed: _____

Linda Phillips
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